

JUN 22 2006

PATENT

App. Ser. No.: 09/865,371
Atty. Dkt. No. ROC920010109US1
PS Ref. No.: IBMK10109**REMARKS**

This is intended as a full and complete response to the Office Action dated April 14, 2006, having a shortened statutory period for response set to expire on July 14, 2006. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-46 are pending in the application. Claims 1-46 remain pending following entry of this response. Claims 1, 16, 27, 38 and 46 have been amended. Applicants submit that the amendments do not introduce new matter.

Claim Rejections - 35 U.S.C. § 103

Claims 1-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bhat* (US 5,668,995) (hereinafter, *Bhat*) in view of *Cline et al.* (US 2002/0087897 A1) (hereinafter, *Cline*).

Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143.

The present rejection fails to establish at least the third criterion. For example, the references, even when combined as suggested in the Office Action, fail to teach the use of receiving information and generating operation profiles for a computer using information obtained from the computer, as recited in independent claims 1, 16, 27, 38, and 46.

The claimed use, as described in the specification, allows evaluation of the actual needs of a user's computer or network of computers directly. In contrast, *Bhat* teaches no such use of receiving information or generating operation profiles for a computer

Page 10

467460_1

PATENT
App. Ser. No.: 09/865,371
Atty. Dkt. No. ROC920010109US1
PS Ref. No.: IBMK10109

using information obtained from the computer, but rather only teaches the use of generating a proposed computer system "in response to user specified requirements" (e.g., see abstract, emphasis added). Likewise, Cline also fails to teach the use of obtaining information from the computer to generate an operation profile, instead only teaching power management of individual devices in a computer system (see page 1, [0011]).

Accordingly, Applicants submit that claims, 1, 16, 27, 38, and 46, as well as their dependents, are allowable and withdrawal of this rejection is respectfully requested.

Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted



Randol W. Read
Registration No. 43,876
PATTERSON & SHERIDAN, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Applicant(s)